

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MASUMI SENOO,  
KAZUO AOYAMA AND SHAHZAD H. BHATTI

Appeal No. 2006-1823  
Application No. 09/506,418

ON BRIEF

MAILED

AUG 28 2006

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before HAIRSTON, RUGGIERO, and MACDONALD, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-12 and 14-18, which are all of the claims pending in this application. Claims 13 and 19-24 have been canceled.

The claimed invention relates to the handling of a print job by a printer in which a determination is made as to whether the entire print job can be processed locally by the printer. If a determination is made that the entire print job cannot be

processed locally, the printer sends the print job, or a portion thereof, to an external rendering device. Upon receipt of the rendered print job from the external rendering device, the printer will proceed to print the rendered print job.

Claim 1 is illustrative of the claimed invention and reads as follows:

1. A method of handling a print job, the method comprising:
  - determining whether the entire print job can be processed by a printer;
  - processing the print job, by the printer, if the entire print job can be processed by the printer;
  - if the entire print job cannot be processed by the printer:
    - sending, by the printer, the print job to an external rendering device;
    - receiving, by the printer, a rendered print job from the external rendering device; and
    - the printer printing the rendered print job received from the external rendering device.

The Examiner relies on the following prior art reference:<sup>1</sup>

Cavill 6,003,069 Dec. 14, 1999

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<sup>1</sup> In addition, the Examiner relies on Appellants' admissions as to the prior art at page 1, line 23 through page 2, line 6 of Appellants' specification.

Claims 1-12 and 14-18, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Cavill in view of the admitted prior art.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>2</sup> and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the

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2 The Appeal Brief was filed May 25, 2005. In response to the Examiner's Answer mailed August 12, 2005, a Reply Brief was filed October 3, 2005, which was acknowledged and entered by the Examiner as indicated in the communication dated December 22, 2005.

particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-12 and 14-18. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based

on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 8, and 15 based on the combination of Cavill and the admitted prior art, Appellants assert (Brief, pages 6-11; Reply Brief, pages 3-5) that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for the proposed combination of references has not been established. After reviewing the

arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

We note, initially, that the language of the appealed independent claims 1, 8, and 15 requires the determination, by the printing device, whether a print job can be processed by the printer and/or the sending, by the printing device, of the print job to an external rendering device. In addressing the language of these claims, the Examiner proposes (final Office action, pages 2 and 3), relying on the teachings of the admitted prior art, to modify the system of Cavill by incorporating the network computer print job processor into the printer device. Our review of the description of the admitted prior art, however, reveals, at best, only a disclosure that printers with integrated processors are known. We find nothing in the disclosures of the admitted prior art or Cavill which would support the Examiner's conclusion of obviousness as to the claimed invention.

In particular, the disclosure of Cavill is directed to a system in which printer driver functions are split between a network computer and a server computer, each of which are structurally separate from printer device 420. Indeed, in direct

contrast to the Examiner's proposed modification of Cavill, the intent of Cavill is to separate the complex operations of the printer driver from the printer device permitting a simpler printer to be utilized. As stated by Cavill at column 8, lines 14-18, "[b]y separating the driver image development between the NC and the server, a very simple, inexpensive printer can print complex graphics that are desired by the user that would not have been possible with the limited processing capability of the NC device."

We also find to be compelling Appellants' argument (Reply Brief, page 5) that, contrary to the Examiner's alleged support in the admitted prior art for the proposed combination, the disclosure of the admitted prior art (specification, page 2, lines 3-6) actually teaches away from the suggested combination. In particular, this portion of the description of the admitted prior art suggests that a printer device, rather than having a processor incorporated into the printer device as alleged by the Examiner, is in fact coupled to a processing device to receive the generated raw print job data.

With the above discussion in mind, it is our view, given the disparity of problems addressed by the applied prior art

references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

For all of the above reasons, since we are of the opinion that the proposed combination of Cavill and the admitted prior art set forth by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1, 8, and 15, nor of claims 2-7, 9-12, 14, and 16-18 dependent thereon.

In summary, we have not sustained the Examiner's rejections of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-12 and 14-18 under 35 U.S.C. § 103(a) is reversed.

Appeal No. 2006-1823  
Application No. 09/506,418

**REVERSED**

*Kenneth W. Hairston* )  
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